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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,981	02/26/2002	Samir Narendra Mehta	320037.403	9077
20280	7590	04/04/2006	EXAMINER JONES, PRENELL P	
MOTOROLA INC 600 NORTH US HIGHWAY 45 ROOM AS437 LIBERTYVILLE, IL 60048-5343			ART UNIT 2616	PAPER NUMBER

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/085,981

Applicant(s)

MEHTA ET AL.

Examiner

Prenell P. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-98 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 81-92 is/are allowed.
- 6) ☐ Claim(s) 1-10, 15-80 and 93-98 is/are rejected.
- 7) ☐ Claim(s) 11-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/21/02</u> . | 6) <input type="checkbox"/> Other: _____ |

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Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 32-80 and 93-98 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding independent claim 32, Applicant is claiming a data structure, which is non-statutory.

Regarding claim 50 and 93, recite a system and a device, without any structure and comprise solely of codes, which are clearly non-statutory.

See MPEP; section 2106, section IV

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 32-80 and 93-98 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

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The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure, which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. Claims 32-80 and 93-98 have no structure because they lack essential elements for implementing the scope of the invention.

2. Claim 43 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 43 recites the limitation "the security key" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not

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commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-8, 15-23, 27, 28, 30-39, 44-57, 64-68, 72 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tucciarone et al (US PG PUB 2003/0009385), Walter et al (US 20020022471) in view of Sussman (US Pat 4,961,158).

Regarding claims 1, 2, 5, 20, 21, 27, 28, 32, 33, 36, 47- 51, 54 and 77, Tucciarone discloses an electronic messaging system wherein the architecture includes making use of a billing transaction mechanism, such as a tracking/billing code generator that implement billing instructions/content, subscriber modifies instruction/information profile/content associated with data request and billing, execution implemented by information exchange after modification to information (Abstract, Fig. 1 & 8a, paragraph 0039, 0041, 0052, 0054, 0127-0129, 0151). Tucciarone is silent on billing/tracking code automatically communicate billing data based upon an amount of data transmitted after content/billing information is modified. In a communication system that also implements billing, Walter discloses in a wireless system that utilize billing algorithms and billing applications residing on wireless device/user device for metering data, wherein charges are calculated based on the amount or volume of data downloaded or uploaded from wireless device (0019), wherein data volume is calculated on a per basis packet (paragraph 0019, 0031-0035), and Sussman discloses determining billing tracking code, instructing determined billing tracking code into the content, thereby modifying the content, modified content is executed on a target device (Abstract, the billing tracking device code automatically communicates billing data based on an amount of data

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transmitted between the modified content and the network (col. 2, line 30-59, col. 3, line 10-30, col. 4, line 1-9, a portable transaction cost tracking device/billing tracking code, wherein transactions are defined by tracking code and cost data, system provides capabilities to edit transaction information/billing application/content used for tracking, cost tracking is calculated automatically, billing calculations utilizing data amount, cost per hour and data quantity, Figs. 3c, 4c & 5b, col. 8, line 34-39, col. 10, line 8-27, col. 11, line 13-27, col. 14, line 41-69). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to implement billing/tracking code automatically communicate billing data based upon an amount of data transmitted as taught by the combined teachings of Walter and Sussman with the teachings of Tucciarone for the purpose of further providing and managing the billing of subscriber data request.

Regarding claim 3, 6, 34, 37, 51, 52 and 55, as indicated above, Tucciarone discloses an electronic messaging system wherein the architecture includes making use of a billing transaction mechanism, such as a tracking/billing code generator that implement billing instructions/content, subscriber modifies instruction/information profile/content associated with data request and billing, execution implemented by information exchange after modification to information (Abstract, Fig. 1 & 8a, paragraph 0039, 0041, 0052, 0054, 0127-0129, 0151). Tucciarone further discloses utilizing the Internet network (Fig. 3, paragraph 0014, 0039).

Regarding claim 4, 7, 35, 38, 53 and 56, as indicated above, Tucciarone and Walter combined, discloses utilizing a billing/tracking code mechanism in determining charge calculated for providing subscribers data/services upon request. However,

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Tucciarone and Walter are silent on communicating data and billing/tracking data as associated in an Internet environment. In a communication system that utilizes billing and tracking devices, wherein the billing is based on the amount/volume of data used, Sussman discloses communicating data/packets are logically linked (col. 1, line 60-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to implement data that is logically linked together as taught by Sussman with the combined teachings of Tucciarone and Walter for the purpose of utilizing memory as efficiently as possible and minimize cost over a given period of time.

Regarding claim 8, 39 and 57, as indicated above, Tucciarone discloses an electronic messaging system wherein the architecture includes making use of a billing transaction mechanism, such as a tracking/billing code generator that implement billing instructions/content, subscriber modifies instruction/information profile/content associated with data request and billing, execution implemented by information exchange after modification to information (Abstract, Fig. 1 & 8a, paragraph 0039, 0041, 0052, 0054, 0127-0129, 0151). Tucciarone further discloses utilizing user request information associated browser plug-ins or pull-downs using JAVA (page 14, Table A).

Regarding claims 15-19, 44-46 and 64-68, as indicated above, Tucciarone discloses an electronic messaging system wherein the architecture includes making use of a billing transaction mechanism, such as a tracking/billing code generator that implement billing instructions/content, subscriber modifies instruction/information profile/content associated with data request and billing, execution implemented by information exchange after modification to information (Abstract, Fig. 1 & 8a, paragraph 0039, 0041, 0052, 0054, 0127-0129, 0151). Tucciarone further discloses the architecture associated

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with a wireless carrier infrastructure, request from subscriber is suggest to be over an Internet, wireless or cellular transmission (paragraph 0039, 0059), content request is downloaded to a target device (paragraph 0088).

Regarding claim 22, as indicated above, Tucciarone discloses an electronic messaging system wherein the architecture includes making use of a billing transaction mechanism, such as a tracking/billing code generator that implement billing instructions/content, subscriber modifies instruction/information profile/content associated with data request and billing. Tucciarone further discloses a plurality of servers communicating data among subscribers, such as, transaction server, email/e-messaging server, Opt-in banner Ad server, request application server, database management server (paragraph 0087, 0088, 0089, 0091, 0092 and 0094).

Regarding claim 23 and 72, as indicated above, Tucciarone discloses an electronic messaging system wherein the architecture includes making use of a billing transaction mechanism, such as a tracking/billing code generator that implement billing instructions/content, subscriber modifies instruction/information profile/content associated with data request and billing, Walter discloses in a wireless system that utilize billing algorithms and billing applications residing on wireless device/user device for metering data, wherein charges are calculated based on the amount or volume of data, and Sussman cost tracking is calculated automatically calculated utilizing data amount, cost per hour and data quantity. Tucciarone and Walter are silent on billing data associated with billing information generates a customer data record. However, Sussman further discloses client table record/customer data record that consist of billing information, such as the amount of billing data, cost limit, cost type, cost per hour and

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cost per item. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to implement customer data record that generates from billing information and billing data as taught by the teachings of Sussman with the combined teachings of Tucciarone and Walter for the purpose of further providing and managing the billing of subscriber data request.

Regarding claim 24, 25, 26, 73, 74 and 75, as indicated above, Tucciarone discloses an electronic messaging system wherein the architecture includes making use of a billing transaction mechanism, such as a tracking/billing code generator that implement billing instructions/content, subscriber modifies instruction/information profile/content associated with data request and billing. Tucciarone further a provider (ISP) promotional panel, wherein it is up to the discretion of provider to waive charges as associated with promotion service usage/billing policies include a promotional offer that provides reduced charges for a designated application, (page 22, lines 10-20), and billing information/instructions (plurality billing policies) provided on behalf of content providers, (paragraph 0021, 0057, 0127, 00156, 00158, page 18, line 33-67, information provider is associated with content provider, wherein billing account information/instructions are located).

Regarding claim 27 and 76, as indicated above, Tucciarone discloses an electronic messaging system wherein the architecture includes making use of a billing transaction mechanism, such as a tracking/billing code generator that implement billing instructions/content, subscriber modifies instruction/information profile/content associated with data request and billing. Tucciarone further discloses provider controls

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charges and fees with respect to billing information/billing data used to provide royalty payments to provider (page 22, lines 10-15).

Regarding claims 30 and 79, as indicated above, Tucciarone discloses an electronic messaging system wherein the architecture includes making use of a billing transaction mechanism, such as a tracking/billing code generator that implement billing instructions/content, subscriber modifies instruction/information profile/content associated with data request and billing. Tucciarone further discloses priority levels associated with the prior usage history (page 15, line 46-67).

Regarding claims 31 and 80, as indicated above, Tucciarone discloses an electronic messaging system wherein the architecture includes making use of a billing transaction mechanism, such as a tracking/billing code generator that implement billing instructions/content, subscriber modifies instruction/information profile/content associated with data request and billing, plurality of servers communicating data among subscribers, such as, transaction server, email/e-messaging server, Opt-in banner Ad server, request application server, database management server (paragraph 0087, 0088, 0089, 0091, 0092 and 0094). Tucciarone further discloses utilizing proxy servers along with forwarding and storing techniques (paragraph 0096, page 17, line 53-65, page 23, line 58-67).

4. Claim 9, 10, 40, 41, 58 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tucciarone et al (US PG PUB 2003/0009385), Walter et al (US 20020022471) and Sussman (US Pat 4,961,158) as applied to claim 1 above, and further in view of Sears et al (US PG PUB 2002/0069263).

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Regarding claim 9, 10, 40, 41, 58 and 59, as indicated above, Tucciarone discloses an electronic messaging system wherein the architecture includes making use of a billing transaction mechanism, such as a tracking/billing code generator that implement billing instructions/content, subscriber modifies instruction/information profile/content associated with data request and billing, Walter discloses in a wireless system that utilize billing algorithms and billing applications residing on wireless device/user device for metering data, wherein charges are calculated based on the amount or volume of data, and Sussman cost tracking is calculated automatically calculated utilizing data amount, cost per hour and data quantity. Tucciarone, Walter and Sussman are silent on content containing byte-code instructions. In a wireless JAVA technology system that utilizes billing applications, Sears discloses providing information to networks as byte-codes in wireless PC based via various applications, such as billing applications (paragraph 0015-0017, 0038, 0048). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to implement byte code as taught by Sears with the combined teachings of Tucciarone, Walter and Sussman for the purpose of further providing and managing the billing of subscriber data request via increase modification of content/application/software.

5. Claims 42, 60 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tucciarone et al (US PG PUB 2003/0009385), Walter et al (US 20020022471) and Sussman (US Pat 4,961,158) as applied to claim 1 above, and further in view of Rojas (US PG PUB 2001/0019605).

Regarding claim 42, 60 and 62, as indicated above, Tucciarone discloses an electronic messaging system wherein the architecture includes making use of a billing transaction

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mechanism, such as a tracking/billing code generator that implement billing instructions/content, subscriber modifies instruction/information profile/content associated with data request and billing, Walter discloses in a wireless system that utilize billing algorithms and billing applications residing on wireless device/user device for metering data, wherein charges are calculated based on the amount or volume of data, and Sussman cost tracking is calculated automatically calculated utilizing data amount, cost per hour and data quantity. Tucciarone, Walter and Sussman are silent on application/content containing security key. In a communication system that utilizes billing applications, Rojas discloses in a communication system which utilizes billing applications (paragraph 0016, 0051), a security key on parallel ports and applications (billing application) on each client to either approve or disapprove purchased use. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to implement a security key with billing applications as taught by Sears with the combined teachings of Tucciarone, Walter and Sussman for the purpose of further providing and securely managing the billing of subscriber data request via increase modification of content/application/software.

Allowable Subject Matter

6. Claims 81-92 are allowed over prior art.
7. Claims 11-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
8. The following is a statement of reasons for the indication of allowable subject matter: Although the combined prior art discloses transaction tracking device that automatically accounts for the amount/quantity of data utilized as

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associated in the determination of billing, utilizing content editing as associated with determining billing as related to user accounts, they fail to teach or suggest fairly with respect to claim 11-14, a security key transmitted with the billing data, and with respect to claim 81, logging the amount of data received with an identifier of the content, transmitting logged amount of data with identifier of the content to a server to be accumulated.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prenell P. Jones whose telephone number is 571-272-3180. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham can be reached on 571-272-3179. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Prenell P. Jones

March 31, 2006


CHI PHAM
SUPERVISORY PATENT EXAMINER
4/3/06